

REMARKS

By this Amendment, Applicant has amended claims 1, 3, 4, 19, and 20, and canceled claim 2 without prejudice or disclaimer of its subject matter. Applicant has also amended the title. Support for the amendments can be found in Applicant's specification at, for example, page 319, line 15 to page 320, line 10, and in original claim 2. Claims 1 and 3-20 remain pending, of which claims 1, 3, 4, 19, and 20 under current examination and claims 5-18 withdrawn from consideration.

In the Office Action¹, the Examiner took following actions:

- (1) required a new title;
- (2) rejected claims 1, 19, and 20 under 35 U.S.C. § 112, second paragraph;
- (3) rejected claim 20 under 35 U.S.C. § 101;
- (4) rejected claims 1-3, 19, and 20 under 35 U.S.C. § 102(e) as being anticipated by Hara et al. (U.S. Patent No. 7,057,645, "*Hara*"); and
- (5) rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Hara* in view of Shimada (U.S. Patent Application Publication No. 2004/0189822, "*Shimada*").

The amendments to the title

Applicant has amended the title so that it is even more clearly indicative of the invention to which the claims are directed, and respectfully requests the Examiner to withdraw the objection to the title.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

The rejection of claims 1, 19, and 20 under 35 U.S.C. § 112

Applicant respectfully traverses the rejection of claims 1, 19, and 20 under 35 U.S.C. § 112, second paragraph. However, to advance prosecution, Applicant has amended claims 1, 19, and 20 to even more clearly comply with § 112, second paragraph, and respectfully requests the Examiner to withdraw the rejection under § 112, second paragraph.

The rejection of claim 20 under 35 U.S.C. § 101

Applicant respectfully traverses the rejection of claim 20 under 35 U.S.C. § 101. However, to advance prosecution, Applicant has amended claim 20 as suggested by the Examiner to embody the claimed invention on “computer-readable medium.” Thus, Applicant respectfully requests the Examiner to withdraw the rejection under § 101.

The rejection of claims 1-3, 19, and 20 under 35 U.S.C. § 102(e)

Applicant respectfully traverses the rejection of claims 1-3, 19, and 20 under 35 U.S.C. § 102(b) as being anticipated by *Hara*. The rejection of claim 2 is rendered moot due to Applicant's cancellation of claim 2. In order to properly establish that *Hara* anticipates claims 1, 3, 19, and 20 under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, (Fed. Cir. 1989).

Hara fails to disclose each and every element of amended claim 1. For example, *Hara* fails to disclose a “control method provided for a photographing apparatus having a first mode for generating an output image by taking one input image and a second

mode for generating an output image by taking a plurality of input images successively without using a binning function,” as recited in amended claim 1 (emphases added).

The Examiner asserts that *Hara* teaches the claimed “second mode” in Fig. 8 (NO in step #130). See Office Action at page 4. This is not correct. *Hara* discloses that “[w]hen the proper integration time T_1 (sec.) is longer than the value $2 \cdot T_0$ (sec.) (NO in Step # 130) : . . . the main controller 300 selects the four pixel data adding mode (Step #150).” Col. 11, lines 5-10 of *Hara*. With respect to the four pixel data adding mode, *Hara* discloses that “quantities of electric charges in four pixels adjoining in both of vertical and horizontal directions are added and outputted as the pixel data.” Col. 7, lines 49-52 of *Hara*. Thus, the four pixel data adding mode of *Hara* may be similar to a “binning function” disclosed in Applicant’s specification. (“The binning function is a function to sum up pixel values of a plurality pixels adjacent to each other inside the image-pickup device 4.” See page 25, lines 11-13 of Applicant’s specification.) Therefore, the four pixel data adding mode of *Hara* cannot constitute the claimed “second mode” which “[generates] an output image by taking a plurality of input images successively without using a binning function,” as recited in amended claim 1.

For at least the above reasons, *Hara* fails to disclose each and every element of and does not anticipate amended claim 1. Claim 1 is therefore allowable, and claims 3 and 4 are also allowable due to their dependence from claim 1.

Independent claims 19 and 20, as amended, although of different scope, recite elements similar to those of claim 1. For at least reasons similar to those discussed above, claims 19 and 20 are allowable over *Hara*.

The rejection of claim 4 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Hara* in view of *Shimada*.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. M.P.E.P. § 2142, 8th Ed., 7 (July 2008). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries...[include determining the scope and content of the prior art and]...[a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). Here, no *prima facie* case of obviousness has been

established, for at least the reason that the Office Action has failed to properly determine the scope and content of the prior art, and has failed to ascertain the differences between the prior art and the claimed combinations.

Claim 4 depends from and includes each and every element of claim 1. As discussed above, *Hara* fails to disclose or suggest a “control method provided for a photographing apparatus having a first mode for generating an output image by taking one input image and a second mode for generating an output image by taking a plurality of input images successively without using a binning function,” as recited in claim 1, and included in claim 4 (emphases added).

Shimada fails to cure the deficiencies of *Hara*. The Examiner asserts that “*Shimada* (Fig. 4) teaches wherein said first threshold value (blur limit shutter speed (hereinafter referred to as Tv)) is a value based on a focal distance (inverse of the focal distance (in mm)).” Office Action at page 11. Even assuming the Examiner’s characterization of *Shimada* is correct, which Applicant does not concede, *Shimada* still fails to disclose or suggest the above-quoted elements recited in claim 1 and included in claim 4.

As set forth above, the Office Action has neither properly determined the scope and content of the prior art nor ascertained the differences between claim 1 and the prior art. Thus, no reason has been articulated as to why one of ordinary skill in the art would find claim 1 obvious. Therefore, a *prima facie* case of the obviousness of claim 1 has not been established, and claim 4 is allowable at least due to its dependence from claim 1.

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 7, 2010

By: /David W. Hill/
David W. Hill
Reg. No. 28,220
(202) 408-4000